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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,786	11/15/2000	Robert P. Arbuckle	T9442	5210

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/714,786

Applicant(s)

ARBUCKLE ET AL.

Examiner

Stephen M Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-102 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 27, 37-41, and 62-77, drawn to a subcombination method, classified in class 705, subclass 14.
- II. Claims 16-26, 28, and 62-77, drawn to a subcombination method, classified in class 705, subclass 1.
- III. Claims 29-35, drawn to a subcombination method, classified in class 705, subclass 10.
- IV. Claim 36, drawn to a subcombination method, classified in class 709, subclass 218.
- V. Claims 42-49, drawn to a combination method, classified in class 705, subclass 50.
- VI. Claims 50-60, drawn to a subcombination method, classified in class 707, subclass 1.
- VII. Claims 61-77, drawn to a subcombination method, classified in class 707, subclass 500.
- VIII. Claims 78-89, drawn to a subcombination method, classified in class 709, subclass 100.
- IX. Claims 90-102, drawn to a subcombination apparatus, classified in class 705, subclass 400.

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The inventions are distinct, each from the other because of the following reasons:

Inventions of group I and groups II-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group I has separate utility such as first, second, and third, graphical positions being located in their respective positions on the graphical layout page to create a second graphical configuration, the visual impression conveyed by the second graphical configuration to the computer user, when the first, second, and third graphical images are placed in the first graphical position, the second graphical position, and the third graphical position, respectively is recognized as the first graphical configuration by the computer user when the graphical layout page is viewed on a video display, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group II and groups I & III-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as first, second, and third, graphic images being positioned on the graphical layout page such that all of the graphical information presented on the first page is also presented on graphical layout page to the computer user when the graphical layout page is viewed on a video display, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group III and groups I, II, & IV-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct

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from each other if they are shown to be separately usable. In the instant case, invention of group III has separate utility such as displaying the graphical and textual material in a visually perceptible manner to the computer user such that the computer user perceives the graphical and textual material on a display in substantially the same arrangement which they appear on the at least one page in the printed publication, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group IV and groups I-III & V-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IV has separate utility such as presenting advertising material which appears in a printed publication to a computer user as defined in claim wherein the step of transmitting the first computer file comprises the step of transmitting the first computer file to the computer user via a TCP/IP protocol, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group V and groups I-IV & VI-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group V has separate utility such as preparing and storing promotional material into a file and manipulating the file for creating a digital image for computer database entry and providing web user access to the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group VI and groups I-V & VII-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VI has separate utility such as providing and directing computer users to geographic locations for promotional material then offering and directing and displaying the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group VII and groups I-VI & VIII-IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VII has separate utility such as providing and directing computer users to geographic locations for promotional material then providing only the promotional material for a selected geographical location, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group VIII and groups I-VII & IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group VIII has separate utility such as providing and directing computer users to geographic locations for promotional material along with a listed of categories of the promotional material then providing and directing a desired category of the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Inventions of group IX and groups I-VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group IX has separate utility such as means for providing and directing computer users to geographic locations for promotional material then providing the promotional material, which is not a limitation in any of the other independently claimed inventions. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since the restriction is complex and examiner knows from past experience that an election will not be made by telephone, this written restriction is proper under MPEP 812.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

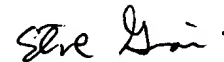
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Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose voice telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The facsimile transmission telephone numbers for TC-3600 are:

After-final (703) 872-9327

Official (703) 872-9306

Non-Official/Draft (703) 872-9325



STEPHEN GRAVINI

PRIMARY EXAMINER

smg

December 15, 2003